

REMARKS

Claims 1-68 are pending. Claims 1-68 were rejected in the Final Office Action dated November 17, 2008.

Claim Rejections Under 35 U.S.C. §102 and §103

Claims 1-14, 16-29, 31-42, 44-68 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent Publication No. 2003/0216174 to Gauselmann ("Gauselmann").

Claims 15, 30 and 43 are rejected under 35 U.S.C. §103(a) as being unpatentable over Gauselmann as applied to claims 1-14, 16-29, 31-42, 44-68 above, and further in view of U.S. Patent Publication No. 2005/0054438 to Rothschild et al. ("Rothschild").

Gauselmann was filed on March 14, 2003 (as a CIP of an application filed on May 14, 2002) and published on November 20, 2003.

As seen in the accompanying affidavit under 37 C.F.R. § 1.131 of Mr. Chauncey Griswold, the subject matter of the present application was conceived before the effective date of Gauselman and diligently reduced to practice, including the parent application to which Gauselman claims priority as a continuation in part.

Therefore Gauselman cannot properly serve as the basis of a rejection under either §102 or §103. Similarly, Rothschild cannot properly serve as the basis of a rejection under either §102 or §103.

According to MPEP 715.07, *Facts and Documentary Evidence, Section 1. General Requirements*, "The essential thing to be shown under 37CFR 1.131 is priority of invention and this may be done by any satisfactory evidence of the fact."

Additionally, MPEP 715.07 states,

...when reviewing a 37 CFR 1.131 affidavit or declaration, the examiner must consider all of the evidence presented in its entirety, including the affidavits or declarations and all accompanying exhibits, records and "notes." An accompanying exhibit need not support all claimed limitations, provided that any missing limitation is supported by the declaration itself. Ex parte Ovshinsky, 10 USPQ2d 1075 (Bd. Pat. App. & Inter. 1989).

According to the Office Action dated 11/17/2008, Gauselman was cited as the basis for a §102 rejection of claims 1, 32, 45, 56, and 64. In support of this rejection, Gauselmann, was

cited as follows:

Claims 1, 32, 45, 56 & 64: Gauselmann discloses of a game play via a gaming apparatus, wherein the gaming apparatus comprises of a value input device to receive a value input from the player (figure 1, elements 22, 24), and causing the first display unit to display a first game (0021, 0020). Gauselmann also discloses of selecting one of plurality of player input displays, wherein the display corresponds to the game related to the first game display (figures 2, 0015, 0020), and the second display to display the selected player inputs (figures 1 & 2), wherein the player input data is received through touch screen for the game (0020, 0026). Gauselmann also teaches of selecting another of player input displays (figure 2), and causing the second display unit to display the selected other of the plurality of player input displays (0026, 0029, 0041), and receive player input data associated with the selected other of the plurality of player input displays via touch screen (0041, 0044). Gauselmann also determines the outcome of the game and awards the player accordingly (0046).

Office Action dated 11/17/2008 at pages 2-3.

As discussed with the Examiner, the affidavit, taken together with the supporting exhibits, establishes that the conception date of the present invention (accompanied with diligence) is prior to the effective date of Gauselmann. In particular, the affidavit and exhibits show that the propositions that Gauselmann is cited for, were first conceived of by Mr. Griswold and his co-inventors.

In particular, it is believed that the primary points at issue are that "Gauselmann discloses...the player input data is received through the touch screen from the game (0020, 0026)... and causing the second display unit to display the selected other of the plurality of player input displays (0026, 0029, 0041), and receive player input data associated with the

selected other of the plurality of player input displays via touch screen (0041, 0044)."

As stated in the affidavit of Mr. Griswold:

4. I conceived of the gaming machine described in U.S. Patent Application No. 10/662,755 at least as early as November 15, 1999. Attached as Exhibit A are two entries from a notebook I used beginning in May 1997. The first entry is dated November 29, 1999. It shows an LCD touch screen for use in a gaming machine. Option #1 shows an LCD touch screen for use as a display and an LCD touch screen for use as an input device with tactile switches placed above the touch screen surface, while option #2 shows a switch or button portion without tactile switches placed above a touch screen surface. The second entry is dated November 18, 1999. It shows a touch screen LCD with thru-touch switches over an LCD touch screen.

Looking at the notebook entry dated November 29, 1999, the LCD screen at the upper left of the entry evidences player input data received through the LCD screen from the game, which would then cause a second display unit (the smaller rectangle between the LCD and the #1) just below the LCD to display the selected other of the plurality of player input displays (below the tactile switches). The gaming machine would then receive player input data associated with the selected other of the plurality of input displays via the touch screen.

Similarly, this is supported by drawing in the middle of the entry above the "#2." The smaller box labeled "LCD" would display the selected other of the plurality of player input displays, and the gaming machine would then receive player input data associated with the selected other of the plurality of input displays via the touch screen.

This supports conception of at least the above mentioned claims and the specification figures 16-18 and the related description beginning at page 24 of the present application.

Furthermore, Mr. Griswold swore to diligence and the invoice/quotation in Exhibit B and drawing in Exhibit C corroborates his affidavit:

5. I diligently worked on the design of the gaming machine and had a prototype of a keypad/tactile switches to be placed over the touch screen made by a vendor Miller Dial at least as early as December 20, 2001. An invoice dated December 20, 2001 is attached as Exhibit B. A drawing dated February 8, 2002 made by Miller dial of the keypad for use over a touch screen is attached as Exhibit C.

Therefore, it is respectfully submitted that the declaratory evidence and supporting documents support that Mr. Griswold and his fellow inventors conceived and reduced to practice the claimed invention before the effective date of Gauselmann or alternatively conceived the claimed invention before the effective date of Gauselmann and then continued to diligently reduce the invention to practice.

Thus, it is further respectfully submitted that: Gauselmann cannot properly serve as the basis of a rejection under either §102 or §103; Rothschild cannot also thus properly serve as the basis of a rejection under either §102 or §103; and that the claims of the application are in condition for allowance.

Information Disclosure Statement

A Supplemental Information Disclosure Statement is being filed herewith. It is respectfully requested that this Supplemental Information Disclosure Statement be considered and the PTO Form 1449 be initialed and returned with the next Action.

CONCLUSION

Accordingly, it is believed that this application is now in condition for allowance and an early indication of its allowance is solicited. Should the Examiner believe that a telephone conference would expedite the prosecution of this application; the undersigned can be reached at the telephone number set out below.

Respectfully submitted,
Weaver Austin Villeneuve & Sampson LLP

/Peter Mikhail/

Peter G. Mikhail
Reg. No. 46,930

P.O. Box 70250
Oakland, CA 94612-0250
510-663-1100